

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John Kenneth BINGHAM et al.
Application No.: 10/509,568
Filed: 26 October 2005
For: A Method of Manufacture of an Automobile Structure Made by the Method
Examiner: Ryan J. WALTERS
Group Art Unit: 3726
Confirmation No. 9584

RESPONSE B – RESPONSE TO SECOND RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of November 20, 2009, Applicants submit the following response:

REMARKS

Claims 1-38 are in the application. Claims 9, 14, 27 and 32 are withdrawn pursuant to a previous restriction requirement. Claims 1-8, 10, 13, 15-26, 28-31 and 33-38 are subject to a restriction requirement. According to the Examiner, the application contains claims directed to the following Groups:

Group 1- Claims 1-8, 10-13, 15-16, 19-26, 28-31, 33-34, and 37-38, drawn to a method of manufacture of an automobile structure.

Group 2- Claims 17-18 and 35-36 drawn to an automobile

In response to the restriction requirement, Applicants provisionally elect Group 1 (Claims 1-8, 10-13, 15-16, 19-26, 28-31, 33-34, and 37-38) solely for the purpose of advancing the case, but such election is made with traverse.

It is believed that the requirement to restrict the invention is improper. In particular, when the Examiner phoned the undersigned to inquire about making an election on the phone, the Examiner informed the undersigned that, at least in part, he was requiring the restriction because “he only examines method claims.”

The MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required

(emphasis added).

Consideration by the Primary Examiner of the Examiner's practice of exclusively examining only method claims as a "serious burden" is respectfully requested.


Furthermore, the claims of Group 1 and Group 2 are sufficiently related that their respective classes would be thoroughly cross-referenced, and many of the same classes would be searched.

It is respectfully requested that the Examiner reconsider and withdraw the restriction requirement.

Respectfully submitted,

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